

REMARKS/ARGUMENTS

The Final Office Action of November 7, 2008 has been received and its contents carefully noted. Claim 26 is amended herein to correct minor antecedent basis issues, with no new matter added thereby. New issues requiring a new search are not introduced. Entry of this Amendment is respectfully requested because it places the present application in condition for allowance, or in the alternative, better form for appeal.

Claims 1-12, 23-24 and 26-31 remain pending. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

A. Request For Withdrawal Of Premature Final Rejection In Accordance With MPEP § 706.07(B)

Applicant hereby requests withdrawal of the Final Office Action mailed November 7, 2008, as premature. The Final Office Action in the present case was the first Office Action mailed after the filing of an RCE with claim amendments.

MPEP § 706.07(b) recites in part,

[t]he claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

The Final Office Action at page 23 states that all claims are drawn to the same invention claimed in the application prior to the submission under 37 C.F.R. § 1.114 and could have been finally rejected on the grounds and art of record in the next Office Action if they been entered in the application under 37 C.F.R. § 1.114.

Applicant respectfully submits this assertion is incorrect, because all the claims are not drawn to the same invention as required by M.P.E.P. § 706.07(b), as the Office has failed to meet criteria (A) of MPEP 706.07(b) for at least the following reasons:

- The scope of claim 23 as amended relative to Applicant's previous Response filed on May 21, 2008 is clearly not the same, as claim 23 was amended in the response dated August 21, 2008 to include the following underlined additional features,
storing in said data store said at least one club type and associated representative user range;
...
determining an inclination to said selected point on said golf course with a tilt sensor in said rangefinding instrument;
determining a wind speed and direction with a wind speed sensor and directional sensor in said rangefinding instrument;
entering other factors in the rangefinding instrument, wherein the other factors include at least one of a golf ball type, altitude, and barometric pressure;
extrapolating a suggested club type appropriate to said determined range from said at least one club type, associated representative user range, inclination, wind speed and direction, and other factors....
- Claims 26-31 were newly added in the Response filed on August 21, 2008. These claims were not previously pending and are not drawn to the same invention. Tellingly, if the claims were drawn to the same invention, then a statutory double patenting rejection under 35 U.S.C. § 101 of newly added claims 26-31 might well be proper. This lack of statutory double patenting rejection with regard to claims 23 and 26-31 confirms that all claims are not the same (i.e., identical) as required by the M.P.E.P. to make a Final rejection on the First Office Action.

In addition, the Office has also failed to meet criteria (B) required by MPEP § 706.07(b). That is, the Office has applied a new ground of rejection in the present Final Office Action as compared to the rejections pending in the Final Office Action of March 21, 2008. Therefore, the claims would not have been properly finally rejected on the same grounds of record in the next Office Action if they had been entered in the earlier application as the rejections have been changed as required by criteria (B).

For at least the reasons set forth above, the finality of the November 7, 2008 Office Action is inappropriate and the Applicant respectfully requests the Office withdraw the finality of the instant Office Action.

B. Rejection of Claims 26-28 and 30 Under 35 U.S.C. § 112, 2nd Paragraph is Addressed

The rejection of claims 26-28 and 30 under 35 U.S.C. § 112, 2nd paragraph as indefinite is respectfully traversed. Independent claim 26 has been amended to remove the word "said" previously limiting the first instances "ground condition" and "other factors". The amendment to claim 26 is made for the sole purpose of clarifying claim 26 and no new matter is added. Therefore, Applicant does not intend to relinquish any subject matter by these amendments. Claim 26, as amended, fully complies with the requirements of 35 U.S.C. § 112, 2nd paragraph.

Accordingly, claim 26 now being in full compliance with § 112, 2nd paragraph, and claims 27, 28 and 30 depending therefrom, withdrawal of the 35 U.S.C. § 112, 2nd paragraph rejection of claims 26-28 and 30 is respectfully requested.

C. Rejection of Claims 23, 29 and 31 as Obvious over *Zeiner-Gundersen*, *Wilens* and *Hines* is Addressed

The rejection of claims 23, 29 and 31 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,059,672 to *Zeiner-Gundersen* in view of U.S. Patent No. 5,779,566 to *Wilens* and U.S. Patent No. 5,933,224 to *Hines, et al* is respectfully traversed, for at least the following reasons.

1. *Zeiner-Gundersen* Fails to Teach or Suggest the Claimed Laser Rangefinder

The rejection is improper because the cited combination does not teach or suggest all of the claimed elements. More particularly, independent claim 23 recites "determining a range to a selected point on a golf course with said rangefinding instrument using a laser rangefinder." (emphasis added). A laser rangefinder as disclosed in the instant application includes devices such as the laser rangefinder described in U.S. Patent No. 5,859,693. See the present specification at page 4. *Zeiner-Gundersen* simply does not disclose a laser rangefinder. In fact, the Office admits *Zeiner-Gundersen* fails to disclose these features in stating *Zeiner-Gundersen*, "does not suggest its use to ascertain distance for longer than a short distance." (Office Action at 5).

Zeiner-Gundersen is primarily directed towards a computerized device for training a golfer in his or her short game. See e.g., *Zeiner-Gundersen* at col. 2, lines 1-10. In fact, *Zeiner-Gundersen* discloses the short game is the "most important portion of the game." See *Zeiner-Gundersen* at col. 2, lines 3-4 (emphasis added). In addition, *Zeiner-Gundersen* discloses the "putting mode [of the device] is the most important of the modes since this is where a player can efficiently cut down on the number of strokes used for each of the holes." See *Zeiner-Gundersen* col. 6, lines 63-65.

Instead of disclosing a laser rangefinder, *Zeiner-Gundersen* discloses a laser distance measuring means at col. 3, lines 13-14, which is utilized in the apparatus. This laser distance measuring means is described as including the following:

[t]he laser distance measuring means is based on a laser having the capability of scanning an area between the ball and the cup in order for the microprocessor to determine the curvature of the green and to calculate the ball trajectory for display on the miniature LCD. Thus by viewing through the unit, the actual view is overlaid by the displayed curvature on the LCD. A high performance retroflective laser scanner will be utilized for the scanning

unit. The unit will have many of the characteristics found on similar scanners used on automatic bottle return machines (scanning and comparing bottle size, type, configuration, etc. to preprogrammed units). (emphasis added).

See *Zeiner-Gundersen* at col. 4, lines 27-38. Such a retroflective laser scanner is simply not a laser rangefinder as required by claims 1 and 26 of the present application. Rather, the retroflective laser scanner of *Zeiner-Gundersen* is configured to determine the curvature of green surface as disclosed above. *Zeiner-Gundersen* also tellingly teaches using simple geometry to determine a distance along the fairway by teaching,

the height of the flag combined with fitting the flag into the tangential function curvature displayed by the microprocessor on the LCD. The LCD will, in addition to the simple curvature, also show the exact information regarding the club the player should use for that distance.

See *Zeiner-Gundersen* at col. 5, ll. 21-25. The foregoing clearly shows using geometry to determine a range, rather than a laser rangefinder as required by independent claims 1 and 26. For at least these reasons, independent claims 1 and 26 are patentably distinguishable over *Zeiner-Gundersen*. In addition, *Wilens* is directed to a handheld computerized golf data reporting unit and fails to cure the deficiencies of *Zeiner-Gundersen*. The Office improperly relies on *Hines* to cure the deficiencies of *Zeiner-Gundersen* and *Wilens*.

2. *Combining Hines with Zeiner-Gundersen Renders the Latter Unsatisfactory for its Intended Purpose*

If a proposed modification to the prior art invention would render the invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01(V) *citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). *Zeiner-Gundersen* repeatedly discloses the most important aspect of the apparatus is assisting a golfer with his short game, which is

clearly the intended purpose of the apparatus taught by *Zeiner-Gundersen*. In the putting mode involving short game assistance, "a curvature ... [is] displayed on the screen and overlaid over the golfer's view of the green." See *Zeiner-Gundersen* at col. 7, lines 11-14. A retroflective laser scanner is used to determine the curvature of the green and to calculate the ball trajectory for display on the miniature LCD. *Id.* at col. 4, lines 27-39. *Hines* discloses using a hand-held distance-measurement apparatus and system utilizing a laser rangefinder. *Hines* also discloses that in some applications, such as golf, the distance may be indicated on the range display only to the nearest yard. See *Hines*, col. 20, lines 56⁺. This distance is determined by placing a reflective target mounted on each of the pins of the golf course, near the top of the pin. *Id.* A light beam from the apparatus reflects off the target back toward the apparatus so that the apparatus can compute the distance. *Id.*

However, there is no teaching in *Hines* of a high performance retroflective laser scanner to scan an area between the ball and the cup in order for the microprocessor to determine the curvature of the green. Rather, as discussed above, *Hines* is directed towards a laser rangefinder to only determine the reflective distance between two points on the golf course. Replacing the high performance retroflective laser scanner of *Zeiner-Gundersen* with the laser rangefinder of *Hines* would simply render *Zeiner-Gundersen* unsatisfactory for its intended purpose of assisting a golfer with his short game. Put another way, *Hines* fails to teach a laser rangefinder capable of being configured to determine the curvature of the green and to calculate the ball trajectory for display on the miniature LCD. Therefore, the combination of *Hines* with *Zeiner-Gundersen* renders *Zeiner-Gundersen* unsatisfactory for its intended purpose. Accordingly, the proposed combination is improper and a *prima facie* case of obviousness has not been established.

3. The Proposed Modification Changes the Principle of Operation of Zeiner-Gundersen

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. § 2143.01(V) *citing In re Ratti*, 270 F.2d 810 (CCPA 1959). Here the combination of *Hines* with *Zeiner-Gundersen* changes the principle of operation of *Zeiner-Gundersen*, as discussed above.

More particularly, the principle of operation of *Zeiner-Gundersen* is its ability to utilize a high performance retroflective laser scanner to scan an area between the ball in order for the microprocessor to determine the curvature of the green, thereby permitting the user to improve his putting game. However, substituting the laser rangefinder of *Hines* destroys the principle operation of *Zeiner-Gundersen* as it does not perform the required determination of a curvature of the green for similar reasons as discussed above.

Accordingly, the proposed combination is improper and is not sufficient to render the claims *prima facie* obvious.

4. *Zeiner-Gundersen* Teaches Away from a Combination with *Hines*

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As discussed herein, *Zeiner-Gundersen* discloses utilizing a high performance retroflective laser scanner to determine the curvature of a green surface. In addition, *Zeiner-Gundersen* discloses using a mil-radian process to determine a range to a selected point on a golf course at col. 5, lines 18-25.

As discussed herein, *Hines* discloses using a laser rangefinder to determine range to a selected point on the golf course. Clearly, the teachings of the mil-radian

process to determine a range to a selected point on the golf course teaches away from the combination with *Hines*.

Moreover, *Zeiner-Gundersen* also discloses that the retroflective laser must have characteristics such as those characteristics found on scanners used on automatic bottle return machines (scanning and comparing bottle size, type, configuration, etc. to programmed units). See *Zeiner-Gundersen* at col. 4, lines 27-39. These features are critical to *Zeiner-Gundersen* in order to provide short game capabilities as described herein. The laser rangefinder of *Hines* does not include these characteristics for similar reasons as discussed herein. Therefore, *Zeiner-Gundersen* when considered in its entirety teaches away from a combination with *Hines*. For this additional reason, the proposed combination is improper and a *prima facie* case of obviousness has not been established.

5. The Proposed Combination of *Hines* with *Zeiner-Gundersen* is Based on Improper Hindsight Reasoning

At the outset, it is noted that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006)(cited with approval in KSR). Also, the U.S. Patent & Trademark Office Board of Appeals has held combinations to be improper when there was "no suggestion to combine the teachings and suggestions [of references], as advanced by the Office, except from using Appellants' invention as a template through a hindsight reconstruction of Appellants' claims." *Ex Parte Crawford et al*, Appeal 20062429, May 30, 2007.

The Office states the rationale for the combination is "improvement for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology, i.e., improved accuracy of distance to target reading for improved club selection." (Office Action at 14). Clearly, this articulated rationale is an unsupported conclusion founded on improper hindsight reasoning based on teachings from the

instant application. Accordingly, the proposed combination is improper and a *prima facie* case of obviousness has not been established. For at least the foregoing reasons, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of claims 23, 29 and 31.

D. Rejection Of Claim 24 As Obvious Over *Zeiner-Gundersen*, *Wilens*, *Maunitz* And *Hines* Is Addressed

The rejection of claim 24 under 35 U.S.C. § 103(a) over *Zeiner-Gundersen* in view *Wilens* and *Hines* and further in view of U.S. Patent No. 5,283,732 to *Maunitz* is respectfully traversed.

By virtue of its dependency from claim 23, claim 24 includes all the features of claim 23, and for the reason given above relative to claim 23, is patentably distinguishable over a combination of *Zeiner-Gundersen*, *Hines* and *Wilens* as the combination fails to teach or suggest all the limitations of claim 23. Additionally, *Mauritz* fails to cure the deficiencies of *Zeiner-Gundersen*, *Hines* and *Wilens*. Accordingly, claim 24 is allowable by virtue of its dependency from claim 23.

E. Rejection Of Claims 1-7, 10, 12, 26 and 30 As Obvious Over *Zeiner-Gundersen*, *Mauritz* And *Hines* Is Addressed

The rejection of claims 1-7, 10, 12, 26 and 30 under 35 U.S.C. § 103(a) over *Zeiner-Gundersen* in view of *Mauritz* and *Hines* is respectfully traversed.

Independent claims 1 and 26 are allowable over the art of record in that claim 23 recites a combination of features including, *inter alia*, "a laser rangefinder for determining a range to a selected point on a golf course." (emphasis added). The applied art of record fails to teach or suggest at least these features for similar reasons as discussed above with respect to independent claim 23. Since each of claims 2-7, 10, 12, and 30 include these same features through dependency, they are also patentably distinguishable over the art of record. Withdrawal of the 35 U.S.C. § 103 rejection of claims 1-7, 10, 12, 26 and 30 is therefore respectfully requested.

F. Rejection of Claims 8-9 and 11 as Obvious over *Zeiner-Gundersen*, *Mauritz*, *Hines* and *Jenkins* or *Jones* is Addressed

Claims 8-9 and 11 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Zeiner-Gundersen* in view of *Mauritz* and *Hines* as applied to claim 1 above, and further in view of U.S. Patent No. 5,294,110 to *Jenkins, et al.* or U.S. Patent No. 4,136,394 to *Jones, et al.* Applicant respectfully traverses this rejection for at least the following reasons.

Claims 8-9 and 11 by virtue of their dependencies from claim 1 include all the features of claim 1. For similar reasons as discussed above with respect to the rejection of claim 1, *Zeiner-Gundersen*, *Mauritz* and *Hines* fail to teach or suggest all the limitations of claim 1. Additionally, *Jenkins* or *Jones* fails to cure the deficiencies of *Zeiner-Gundersen*, *Mauritz* and *Hines*. Accordingly, claims 8-9 and 11 are allowable by virtue of their dependencies from claim 1.

G. Rejection of Claims 27-28 as Obvious over *Zeiner-Gundersen*, *Mauritz*, *Hines* and *Wilens* is Addressed

Claims 27-28 stand rejected under 35 U.S.C. § 103(a) over *Zeiner-Gundersen* in view of *Mauritz* and *Hines* as applied to claim 26 above, and further in view of *Wilens*. Applicant respectfully traverses this rejection, as claims 27-28, by virtue of their dependencies from claim 26, include all the features of claim 26. As discussed above with respect to the rejection of claim 26, *Zeiner-Gundersen*, *Mauritz* and *Hines* fail to teach or suggest all the limitations of claim 26 and *Wilens* fails to provide the missing teachings. Claims 27-28 are allowable by virtue of their dependencies from claim 26.

H. Conclusion

The Office Action alleges the Amendment filed on August 21, 2008 failed to adequately indicate support for the claim amendments. Previously amended claim 23 and newly added claims 26-31 are fully supported by Applicant's original disclosure, as can be seen, e.g., from a review of FIG. 3 and related text of the

specification at pages 6-9 disclosing features of the previously amended claim 23 and newly added claims 26-31. Originally filed claims 1-25 as providing support for the previous amendments, with no new matter added in the amendment filed on August 21, 2008.

It is believed that a full and complete response has been made to the pending Office Action and all grounds for rejection have been overcome, the application is now in form for allowance. Should the Office feel that there are any issues outstanding after consideration of this Response, the Office is invited to contact the undersigned by phone to expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested.

The undersigned hereby petitions for a 1-month extension for response. Please charge Deposit Account No. 50-1123 the one-month extension fee of \$130 and any other fees deemed associated with this filing.

Respectfully submitted,

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Scott J. Hawranek, No. 52,411
Hogan & Hartson LLP
One Tabor Center
1200 17th Street, Suite 1500
Denver, Colorado 80202
(719) 448-5920 Tel
(303) 899-7333 Fax